APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,476	06/28/2001	Andrew Comas	72167.000564	5938

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER
GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
3696	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/894,476	COMAS ET AL.
	Examiner	Art Unit	
	Clement B. Graham	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2008*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

SUPPLEMENTIAL ACTION

1.   Claims 1-12 remained pending in this Application.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness
rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Underwood US Patent 6, 601, 233 in view of Srinivasan et al (Hereinafter Srinivasan

U.S Patent 6, 895, 382).

As per claim 1, Underwood discloses a computer implemented method for

structured development of migration options in a legacy transactional enterprise, the

method comprising:

identifying components of the legacy enterprise;

developing risk factors for the components of the legacy enterprise; identifying unmet

opportunities, developing risk factors for the unmet opportunities; identifying potential

components for the legacy enterprise (see column 117 lines 10-67 and column 118 lies

1-22 and column 55-57 lines 1-65) developing risk factors for the potential components

of the legacy enterprise; with associated risks using at least the risk factors for the

components, the risk factors for the unmet opportunities and the risk factors for the

potential components and.(Note abstract and (see column 117 lines 10-67 and column

118 lies 1-22 and column 55-57 lines 1-65).

Underwood fail to explicitly teach providing by a computer migration options and

developing by a computer the migration options.

However Srinivasan discloses providing by a computer migration options and developing by a computer the migration options (see column 2 lines 1-76 and column 8 lines 18-46 and table 1, 3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Underwood to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

As per claim 2, Underwood discloses wherein the components of the legacy enterprise are selected from the group consisting of hardware or software (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 3, Underwood discloses wherein the unmet opportunities are selected from the group consisting of new hardware, new software or new business methods (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65). As per claim 4, Underwood discloses wherein the potential components for the legacy enterprise are selected from the group consisting of hardware or software (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 5, Underwood discloses wherein the potential components for the legacy enterprise include conceptual models of undeveloped capabilities (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 6, Underwood discloses wherein the risk factors include multiple variables (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 7, Underwood discloses wherein the risk factors are selected from the group consisting of cost or schedule (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 8, Underwood discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual

models of undeveloped capabilities (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 9, Underwood discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

As per claim 10, Underwood discloses computer executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise;

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities(see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture risk factors for the unmet opportunities; code to capture identity of potential components for the legacy enterprise (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture risk factors for the potential components of the legacy enterprise and code with associated risks using at least the risk factors for the components the risk factors for the unmet opportunities and the risk factors for the potential components (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

Underwood fail to explicitly teach providing by a computer migration options and developing by a computer the migration options.

However Srinivasan discloses providing by a computer migration options and developing by a computer the migration options (see column 2 lines 1-76 and column 8 lines 18-46 and table 1,3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Underwood to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain

advantages of lower costs and significantly larger skill pools with equivalent or higher
quality of service.

As per claim 11, Underwood discloses a computer-readable medium having
computer executable software code stored thereon, the code for structured
development of migration options in a legacy transactional enterprise, the code
comprising:
code to capture identity of components of the legacy enterprise(see column 117 lines
10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture risk
factors for the components of the legacy enterprise; code to capture identity of unmet
opportunities(see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57
lines 1-65). code to capture risk factors for the unmet opportunities;
code to capture identity of potential components for the legacy enterprise (see column
117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture
risk factors for the potential components of the legacy enterprise, and code with
associated risks using at least the risk factors for the components, the risk factors for
the unmet opportunities and the risk factors for the potential components (see column
117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

 Underwood fail to explicitly teach providing by a computer migration options and
developing by a computer the migration options.

However Srinivasan discloses providing by a computer migration options and
developing by a computer the migration options (see column 2 lines 1-76 and column 8
lines 18-46 and table 1, 3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time
the invention was made to modify the teachings of Underwood to include providing by a
computer migration options and developing the migration options taught by Srinivasan
in order to arrive at a optimal decision to migrate the development, conversion, support
and maintenance of software applications to off shore/off site locations to gain
advantages of lower costs and significantly larger skill pools with equivalent or higher
quality of service.

As per claim 12, Underwood discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising: a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture identity of components of the legacy enterprise code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities, code to capture risk factors for the unmet opportunities (see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65) code to capture identity of potential components for the legacy enterprise; code to capture risk factors for the potential components of the legacy enterprise; and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components(see column 117 lines 10-67 and column 118 lies 1-22 and column 55-57 lines 1-65).

Underwood fail to explicitly teach providing by a computer migration options and developing by a computer the migration options

However Srinivasan discloses providing by a computer migration options and developing by a computer the migration options (see column 2 lines 1-76 and column 8 lines 18-46 and table 1, 3b).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Underwood to include providing by a computer migration options and developing the migration options taught by Srinivasan in order to arrive at a optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations to gain advantages of lower costs and significantly larger skill pools with equivalent or higher quality of service.

Response to Arguments

4. Applicant's arguments filed 8/12/08 have been fully considered but they are moot in view of new grounds of rejections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

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